

REMARKS

This Amendment is being entered in response to the Office Action of August 6, 2004. In this Office Action, the Examiner made the following objections and rejections:

- 5 1. The Examiner has objected to Figure 5.
2. The Examiner has objected to the Specification.
3. The Examiner has objected to claims 1-39 on formal grounds.
4. The Examiner has objected to claim 1 under 35 U.S.C. 103(a) as being allegedly obvious in view of Suzuki.
- 10 5. The Examiner has rejected claims 1-3, 35, and 38-40 under 35 U.S.C. 103(a) as being allegedly obvious in view of Yamaguchi.
6. The Examiner has rejected claims 1-3, 15-16, and 18 under 35 U.S.C. 103(a) as being allegedly obvious in view of Saito in further view of Wen.
- 15 7. The Examiner has rejected claims 1-2, 4, and 41 under 35 U.S.C. 103(a) as being allegedly obvious in view of Miyazaki.
8. The Examiner has rejected claims 5-8 under 35 U.S.C. 103(a) as being allegedly obvious in view of Saito in view of Wen, in further view of Yamaguchi.
- 20 9. The Examiner has rejected claim 17 under 35 U.S.C. 103(a) as being allegedly obvious in view of Saito in view of Wen, in further view of Sazuki.
10. The Examiner has rejected claims 1-3, 15, 19-21, 24, and 27 under 35 U.S.C. 103(a) as being allegedly obvious in view of Defieuw in further view of Wen.
- 25 11. The Examiner has rejected claims 22-23 under 35 U.S.C. 103(a) as being allegedly obvious in view of Defieuw in view of Wen in further view of Kubodera.
12. The Examiner has rejected claim 29 under 35 U.S.C. 103(a) as being allegedly obvious in view of Defieuw, in view of Wen in further view of Araki.
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13. The Examiner has rejected claim 30 under 35 U.S.C. 103(a) as being allegedly obvious in view of Defieuw, in view of Wen in further view of Bellmann.

14. The Examiner has rejected claim 32 under 35 U.S.C. 103(a) as being allegedly obvious in view of Suzuki in view of Kutami.

15. The Examiner has acknowledged that claims 42-46 are allowed.

16. The Examiner has substantially allowed claims 9-14, 25-26, 28, 31, 33-34, and 36-37.

SUMMARY OF CHANGES

The applicants have entered amendments that address the formal issues raised by the Examiner in objections 1-3. Likewise, the applicants have rewritten certain claims in independent format so as to place them in condition for allowance (objection 16). The remaining disputed claims have been canceled with traverse. As such, all outstanding claims are now in condition for allowance. Reconsideration is respectfully requested.

1. THE EXAMINER HAS OBJECTED TO FIGURE 5

The Examiner has objected to Figure 5 stating:

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **429** (as shown in Figure 5).

Applicants believe that the Examiner's reference to element "429" was intended to refer to element "249." If the Examiner disagrees as to be applicant's interpretation, he is invited to contact applicants' agent.

To clarify their invention, applicants have amended the specification to recite element 249. As illustrated in Figure 5, element 248 refers to a "face side" and element 249 refers to a "backside." The bases for this amendment may be found in Figure 5. Additional grounds for this amendment may also be found in the specification. For example, on page 24, beginning at line 5 it is stated:

In the embodiment depicted, the ribbon 250 is comprised of a flexible substrate 251 with a heat resistant back-coating 252 on back side and an imaging ink layer 253 on the face side 248.

5 It is respectfully submitted that the amendment to the specification obviates the objection to Figure 5. Applicants note that this same amendment to the specification addresses the Examiner's objection to the specification, found in section two of this amendment.

10 **2. THE EXAMINER HAS OBJECTED TO THE SPECIFICATION**

 The Examiner has objected to the specification stating:

 The disclosure is objected to because of the following informalities: on pages 23-24, the statement that, "affixed to the back surface 248 of the ribbon substrate 251 is the back-coating 252" does not appear to be correct. Figure 5 of applicant's drawings shows that surface 248 and back coating 252 do not contact one another. Appropriate correction is required.

20 Applicants have amended the specification to correct a typographical error which caused the confusion. The specification is now consistent with Figure 5 of the specification as filed.

 Page 23, line 19 of the specification as filed erroneously referred to "back surface 248." One of ordinary skill in the art, would have appreciated this typographical error and clearly seen that the specification should read "back surface 249." This reading of the specification is consistent with Figure 5. Applicants have entered an appropriate amendment. It is respectfully submitted that the Examiner's objection to the specification has been obviated.

3. OBJECTION TO CLAIMS 1-39 ON FORMAL GROUNDS

The Examiner has objected to claims 1-39 because of informalities. In regard to claim 1, the Examiner stated:

In claim 1, applicant's recitation of, "said first front side is comprised of a multiplicity of first particles" appears to contradict the establishment of front and back sides in the specification as defined on page 22, lines 3-8, it appears that applicant has established the lower sides of the layers (as shown in Figure 5) as the front sides or the face sides. Correction and/or clarification is required.

Applicants have amended the claims in accordance with the Examiner's suggestion. This amendment has been carried forward into several dependent claims so as to ensure consistency. However, applicants would like to clarify for the record that the terms "front" and "back" are given their ordinary meaning. For example, the New Shorter Oxford English Dictionary, Volume 1, defines "front" as "the side or part of an object which appears to look out or to present itself to the view." The ordinary meaning of the words clearly illustrate that the terms "front" and "back" are relative terms that depend on the perspective of the viewer.

For example, and with reference to Figure 5, the specification identifies element 248 as a "front side" and element 249 as a "back side." As drawn in Figure 5, element 248 is proximal to the viewer, so it is natural to assume 248 is "front." But if one were to invert the paper, then 249 is proximal to the viewer, and hence 249 is then "front."

In addition to the aforementioned objection, the Examiner has also objected to claims 19 and 35 based on other formal grounds. While applicants do not necessarily agree that the present objections are proper, applicants have canceled claims 19 and 35 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

**4. THE EXAMINER HAS OBJECTED TO CLAIM 1 UNDER 35 U.S.C. 103(A)
AS BEING ALLEGEDLY OBVIOUS IN VIEW OF SUZUKI.**

While applicants do not necessarily agree that the present claim is obvious in view of Suzuki, applicants have canceled claim 1 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

**5. THE EXAMINER HAS REJECTED CLAIMS 1-3, 35, AND 38-40 UNDER 35
U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF YAMAGUCHI.**

While applicants do not necessarily agree that the present claims are obvious in view of Yamaguchi, applicants have canceled claims 1-3, 35, and 38-40 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

**6. THE EXAMINER HAS REJECTED CLAIMS 1-3, 15-16, AND 18 UNDER 35
U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF SAITO IN
FURTHER VIEW OF WEN.**

While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claims 1-3, 15-16, and 18 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

Applicants would like to note for the record that no English translation of underlying text of the Saito reference was provided. Only a translation of the abstract was enclosed with the present Office action. The underlying document was in a language other than English (presumably Japanese). In support of this fact, applicants hereby reference the PTO-892 form ("Notice of Referenced Cited") that was enclosed with the present Office action. Page 1 of this Notice lists items U, V, X, X, which corresponds to the machine translations of the Yamaguchi, Kutami, Miyazaki, and Kubodera references. Furthermore, page 2

of this notice lists item U which corresponds to the machine translation of the Araki reference. Notably absent is a machine translation of the Saito reference.

On August 31, 2004 applicants' agent contacted the Examiner by telephone to request a translation of the Saito reference. The Examiner informed the agent that translations of older Japanese patents are not readily available. The Examiner then informed the agent that he would continue to attempt to obtain a translation. To date, no such translation has arrived. Please consider this paragraph a "reduction to writing" as required by M.P.E.P. § 713.04.

Applicants respectfully note that the Office has an obligation to obtain an English translation so that the record may be made clear. M.P.E.P. § 706.02 (II) states:

If the document is in a language other than English and the examiner seeks to reply on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is replying upon in support of the rejection. The record must also be clear as to whether the examiner is replying upon the abstract or the full text document to support a rejection."

This section of the M.P.E.P. then recites the underlying rationale behind this requirement. For example, M.P.E.P. § 706.02 (II) states

"...the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103 when the abstract alone appears to support the rejection.

As no English translation of the Saito reference was provided, any obviousness rejection that uses the Saito reference must be improper, as the full text document may contain teachings away that will preclude an obviousness rejection. The applicants' cancellation of the disputed claims has rendered this issue moot. Nevertheless, applicants would like to note for the record that they

believe such an obviousness rejection is not in compliance with the guidelines of the M.P.E.P., and as such, is improper.

7. THE EXAMINER HAS REJECTED CLAIMS 1-2, 4, AND 41 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF MIYAZAKI.

While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claims 1-2, 4, and 41 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

8. THE EXAMINER HAS REJECTED CLAIMS 5-8 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF SAITO IN VIEW OF WEN, IN FURTHER VIEW OF YAMAGUCHI.

While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claims 5-8 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

9. THE EXAMINER HAS REJECTED CLAIM 17 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF SAITO IN VIEW OF WEN, IN FURTHER VIEW OF SAZUKI.

While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claim 17 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

10. THE EXAMINER HAS REJECTED CLAIMS 1-3, 15, 19-21, 24, AND 27 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF DEFIEUW IN FURTHER VIEW OF WEN.

5 While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claims 1-3, 15, 19-21, 24, and 27 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

10 **11. THE EXAMINER HAS REJECTED CLAIMS 22-23 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF DEFIEUW IN VIEW OF WEN IN FURTHER VIEW OF KUBODERA.**

15 While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claims 22-23 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

20 **12. THE EXAMINER HAS REJECTED CLAIM 29 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF DEFIEUW, IN VIEW OF WEN IN FURTHER VIEW OF ARAKI.**

25 While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claim 29 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

13. THE EXAMINER HAS REJECTED CLAIM 30 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF DEFIEUW, IN VIEW OF WEN IN FURTHER VIEW OF BELLMANN.

30 While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claim 30 to

facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

5 **14. THE EXAMINER HAS REJECTED CLAIM 32 UNDER 35 U.S.C. 103(A) AS BEING ALLEGEDLY OBVIOUS IN VIEW OF SUZUKI IN VIEW OF KUTAMI.**

While applicants do not necessarily agree that the present claims are obvious in view of the cited references, applicants have canceled claim 32 to facilitate the prosecution of this application. Applicants specifically wish to reserve the right to argue this alleged obviousness rejection in a continuation application.

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15. THE EXAMINER HAS ACKNOWLEDGED THAT CLAIMS 42-46 ARE ALLOWED.

Claims 42-46 are allowed.

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Applicants would like to thank the Examiner for the first action allowance of claims 42 to 46. The Examiner has allowed these claims in their original form.

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16. THE EXAMINER HAS SUBSTANTIALLY ALLOWED CLAIMS 9-14, 25-26, 28, 31, 33-34, AND 36-37.

The Examiner has substantially allowed claims 9-14, 25-26, 28, 31, 33-34 and 36-37 in their original form stating:

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Claims 9-14, 25-26, 28, 31, 33-34 and 36-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claim 9 has been re-written in independent form, including all of the limitations of the base claim and all intervening claims. As such, claim 9 is now in condition for allowance. In addition, claims 11, 13, and 14 depend, either directly or

indirectly, upon re-written claim 9. As such, claims 11, 13, and 14 are likewise in condition for allowance.

5 Claim 10 has been re-written in independent form, including all of the limitations of the base claim and all intervening claims. As such, claim 10 is now in condition for allowance. In addition, claim 12 depends directly upon re-written claim 10. As such, claim 12 is likewise in condition for allowance.

10 Claims 25 and 26 have been re-written in independent form, including all of the limitations of the base claim and all intervening claims. As such, claims 25 and 26 are now in condition for allowance. In addition, claims 36 and 37 depend, either directly or indirectly, upon re-written claim 26. As such, claim 36 and 37 are likewise in condition for allowance.

15 Claim 28 has been re-written in independent form, including all of the limitations of the base claim and all intervening claims. As such, claim 28 is now in condition for allowance. In addition, claim 31 depends directly upon re-written claim 28. As such, claim 31 is likewise in condition for allowance.

Claims 33 and 34 have been re-written in independent form, including all of the limitations of the base claim and all intervening claims. As such, claims 33 and 34 are now in condition for allowance.

CONCLUSION


The applicants have entered amendments that address the formal issues raised by the Examiner in objections 1-3. Likewise, the applicants have rewritten selected claims in independent format so as to place them in condition for allowance (objection 16). The remaining disputed claims have been canceled with traverse. As such, all outstanding claims are now in condition for allowance.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. If, for any reason, the Patent Examiner believes that a telephone conference with applicants' agent might in any way facilitate the prosecution of this case, the Examiner is respectfully requested to call such agent.

To the extend necessary, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-2753 and credit any excess fees to such deposit account. If necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made.

Respectfully submitted,

Howard J. Greenwald P.C.

By 

Peter J. Mikesell

Reg. No. 54,311

Telephone (585) 387-0285

Fax (585) 387-0288